

REMARKS

Applicants request favorable reconsideration and allowance of the subject application in view of (i) the preceding amendments, (ii) the Declaration of Renata Ferraiolo Leite Pereira Under 37 C.F.R. § 1.132 (“Pereira Declaration”), dated May 6, 2005, and submitted concurrently herewith, evidencing the commercial success of the present invention, and (iii) the following remarks.

Claim Status

Claims 1-26 are pending and presented for consideration. Claims 1, 10, and 17 are independent. Claims 17, 19, and 24 have been amended to clarify features of the subject invention. Support for these changes can be found in the application, as originally filed. Therefore, no new matter has been added.

Rejected Claims

Applicants request favorable reconsideration and withdrawal of the rejection set forth in the Office Action.

Claims 1-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,554,448 to Carpenter et al. (“Carpenter”) alone and further in view of Exhibit 13 as presented by Applicants. Applicants submit that the present invention, as recited in independent claims 1, 10, and 17, is not obvious over either (i) Carpenter or (ii) Carpenter in view of Exhibit 13, especially given the invention’s commercial success as evidenced by the Pereira Declaration. Therefore, this rejection is respectfully traversed, as discussed below.

In one aspect of the present invention, independent claim 1 recites a decorated luminary product comprising a candle and a candle holder containing the candle. The candle holder has an inner surface and an outer surface, along with a web of a heat shrunk polymer encasing the outer surface of the candle holder. The web includes a decorative feature. At least one of the inner surface and the outer surface of the candle holder has a hammered texture. The decorative feature of the web is located so as to

cooperate with light emitted by the candle in the candle holder to augment a visual effect when the candle is lit.

In another aspect of the present invention, independent claim 10 recites a decorated luminary product comprising a candle and a candle holder selected from the group consisting of chimneys, globes and jars, containing the candle. The candle holder has an inner surface and an outer surface, along with a web of a heat shrunk polymer encasing the candle holder. The web includes a decorative feature. At least one of the inner surface and the outer surface of the candle holder has a hammered texture. The decorative feature of the web is located so as to cooperate with light emitted by the candle in the candle holder to augment a visual effect when the candle is lit.

In yet another aspect of the present invention, independent claim 17 recites a luminary product comprising a combustible material. A glass jar contains the combustible material, which has been poured into the glass jar. The glass jar has an inner surface and an outer surface, along with a web of a heat shrunk polymer encasing the outer surface of the glass jar. A wick extends through the combustible material. At least one of the inner surface and the outer surface of the glass jar has a hammered texture such that light passing through the glass jar varies substantially as a result of variation of refraction of the light.

Carpenter

Carpenter relates to a decorated luminary product. That luminary product comprises either a candle or a candle holder containing the candle. A decorative web of a heat-shrinkable polymer web is heat shrunk to conform to a shape of the candle or candle holder. The web is decorated with a thermochromic ink or pigmentation to cooperate with heat emitted by burning the candle to provide a visible change in the ink or pigmentation. However, as explained by the Examiner, Carpenter “does not specifically recite the inner and outer surface of the candleholder as having a hammered texture.” (Office Action, 12/16/04, p. 3.)

The Examiner nevertheless rejected Claims 1-26 as being obvious over Carpenter alone. In doing so, however, Applicants respectfully submit that the Examiner impermissibly broadened Carpenter's *actual* disclosure. The Examiner argued:

It would have been obvious ... to use the candle holder with a hammered texture inside and out because as taught by Carpenter such candle holders *with structurally non smooth outer features* would only be further enhanced by the decorative film as taught by applicant.

(*Id.* (emphasis added).) But Carpenter does not teach that. Instead, Carpenter discloses that “[a base wrap] will augment any surface features (e.g., fillets, flutes or the like) of a candle holder 25 in a similar manner as would tinted glass.” (Carpenter, col. 9, lines 14-16.) Carpenter does not describe, teach, or suggest the *structural combination* of the present invention, which includes at least one of the inner surface and the outer surface of the candle holder having a *hammered* texture. See *In re Mills*, 916 F.2d 680, 683 (Fed. Cir. 1990) (“It is not pertinent whether the prior art device possesses the functional characteristics of the claimed invention if the reference does not describe or suggest *its structure.*”) (emphasis added). Indeed, the Examiner does not explain how a disclosure of “fillets,” “flutes,” or “any surface features” clearly and particularly teaches a candle holder having a *hammered* texture, without relying on Applicants’ disclosure and the benefit of hindsight.

Applicants submit, therefore, that Carpenter fails to obviate salient features of Applicants’ present invention, as recited in independent claims 1, 10, and 17, such as at least one of the inner surface and the outer surface of the candle holder having a *hammered* texture.

In addition, Applicants submit herewith the Pereira Declaration, which objectively evidences the commercial success of the present invention (discussed below).

Carpenter in View of Exhibit 13

The Examiner also rejected Claims 1-26 over Carpenter in view of Exhibit 13, relying on the same argument set forth in the Carpenter rejection:

It would have been obvious ... to use the candle holder with a hammered texture inside and out because as taught by Carpenter such candle holders *with structurally non smooth outer features* would only be further enhanced by the decorative film as taught by applicant.

(Office Action, 12/16/04, p. 3 (emphasis added).) The Examiner stated that Exhibit 13 discloses a candle holder with “a hammered texture inside and out.” (*Id.*) An image of that candle holder from Exhibit 13 is reproduced below.



Exhibit 13 Candle Holder

As a preliminary point, Applicants submit that the glass candle holder of Exhibit 13 has a hammered texture *only on the outside*. To verify, Applicants obtained a physical embodiment of the Exhibit 13 candle holder. If the Examiner wishes to examine the actual glass candle holder, Applicants request that the Examiner contact Applicants' undersigned counsel. In any event, Applicants do not rely on this point in arguing the patentability of the pending claims.

As explained above, Carpenter does not describe, teach, or suggest the *structural combination* of the present invention, which includes at least one of the inner surface and the outer surface of the candle holder having a *hammered* texture. Moreover, Carpenter's disclosure that “[a base wrap] will augment any surface features (e.g., fillets, flutes or the like) of a candle holder” does not clearly and particularly show the desirability of its combination with Exhibit 13. See *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1348-49 (Fed. Cir. 2000) (“Although a reference need not expressly teach

that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be ‘*clear and particular.*’”) (internal citations omitted, emphasis added). Indeed, the Examiner does not explain how a disclosure of “fillets,” “flutes,” or “any surface features” clearly and particularly suggests a candle holder having a *hammered* texture, without relying on Applicants’ disclosure and the benefit of hindsight. Contrarily, Exhibit 13 merely depicts a physical embodiment of an empty “Heart Votive Holder” made of “hammered glass,” and fails to suggest the desirability of its combination with Carpenter. See *In re Mills*, 916 F.2d at 682 (mere fact that references *can* be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination). At most, the combination suggested by the Examiner would have been ‘obvious to try,’ which is not to be equated with obviousness under 35 U.S.C. § 103.

Likewise, Applicants submit that the inherent properties of Exhibit 13’s hammered glass candle holder do not cure its inability to *clearly and particularly* suggest the subject prior art combination, for the reasons explained above. Further, the Examiner’s own statement that *all* “irregular textures” cause distinctive light effects, (Office Action, 12/16/04, p. 3), contradicts any finding that such inherent properties could *clearly and particularly* suggest the precise combination with Carpenter—without hindsight.

Applicants submit, therefore, that Carpenter in view of Exhibit 13 also fails to obviate salient features of Applicants’ present invention, as recited in independent claims 1, 10, and 17, such as at least one of the inner surface and the outer surface of the candle holder having a *hammered* texture with a web of a heat shrunk polymer encasing the outer surface of the candle holder.

In addition, Applicants submit herewith the Pereira Declaration, which objectively evidences the commercial success of the present invention (discussed below).

Commercial Success – Pereira Declaration

An analysis of obviousness *must* address objective evidence of nonobviousness, such as the commercial success of the claimed invention. *See Gillette Co. v. S.C. Johnson & Son, Inc.*, 919 F.2d 720, 725 (Fed. Cir. 1990) (citing *Graham v. John Deere Co.*, 383 U.S. 1 (1966)) (S.C. Johnson’s objective evidence of commercial success with EDGE® shaving gel supported nonobviousness of claims thereto; contrary arguments “boil[ed] down to no more than hindsight reconstruction”).

Accordingly, Applicants respectfully submit the Pereira Declaration to evidence the commercial success of the present invention, and request consideration thereof by the Examiner.

Applicants’ Assignee, S.C. Johnson & Son, Inc. (“S.C. Johnson”) sells GLADE® scented candle products as disclosed in and embodying one or more claims in the present application, and specifically comprising a candle holder having a hammered texture on an inner surface thereof. (*See* Pereira Declaration at ¶¶ 6-9.) These products are a commercial success. (*See id.* at ¶¶ 12-15.)

A nexus exists between the commercial success evidenced and the invention as claimed in each of independent claims 1, 10, and 17. (*See id.* at ¶¶ 6-15.) *See Demaco Corp. v. F. Von Langsdorff Licensing, Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988) (“A *prima facie* case of nexus is generally made out when the patentee shows both that there is commercial success, and that the thing ... that is commercially successful is the invention disclosed and claimed in the patent.”). Indeed, the substantial difference between S.C. Johnson’s previously sold candles and those embodying the present invention is the hammered texture on the inner surface of the candle holder. (*See id.* at ¶ 9.) After its transition to GLADE® scented candle products corresponding to the present invention, S.C. Johnson’s share per %ACV (defined in the Pereira Declaration) increased for all five fragrances previously sold. (*See id.* at ¶ 14.)

Such commercial success does not derive from promotion, tying, advertising, shift in advertising, market power, or other factors extraneous to the merits of the present invention. (*See id.* at ¶¶ 12-14.) Moreover, Applicants need not submit “proof of the negative of all imaginable contributing factors” potentially leading to that

commercial success. *See Demaco*, 851 F.2d at 1394 (patentee “not required to prove as part of its *prima facie* case that the commercial success of the patented invention is *not* due to factors other than the patented invention”).

Applicants submit, therefore, that the Pereira Declaration further evidences the nonobviousness of the present invention, as recited in independent claims 1, 10, and 17.

Dependent Claims

Dependent claims 2-9, 11-16, and 18-26 also should be deemed allowable, in their own right, for defining other patentable features of the present invention in addition to those recited in their respective independent claims. Further individual consideration of these dependent claims is requested.

Conclusion

Applicants further submit that the instant application is in condition for allowance. Favorable reconsideration, withdrawal of the rejection set forth in the above-noted Office Action, and an early Notice of Allowance are requested.

Applicants’ undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to the address given below for S.C. Johnson & Son, Inc.

Respectfully submitted,



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